Serial No. 09/458,321
Page 8 of 13

REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed June 16, 2004. In the Office Action, the Examiner notes that claims 10-13, 15-18, and 20-29 are pending, of which claims 10-13, 15-18 and 20-29 stand rejected. By this response, claims 10-13, 15-18, 20-26, and 28-29 continue unamended, and new claims 30-32 are added.

In view of the following discussion, the applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103. Thus, the applicants believe that all these claims are now in allowable form.

REJECTIONS

35 U.S.C. §103

Claims 10-13, 15-18 and 20-29

The Examiner has rejected claims 10-13, 15-18, 20-26, and 28-29 as being obvious under 35 U.S.C. §103 over Sahai (U.S. Patent No. 6,594,699, hereinafter "Sahai") in view of Shaw et al. (U.S. Patent No. 6,104,392, hereinafter "Shaw") and Utsumi (U.S. Patent No. 6,195,677, hereinafter "Utsumi"). The Applicants respectfully traverse the rejection.

The Applicants' Independent claim 10 (and similarly independent claims 17 and 23) recites:

> "A method of adapting asset delivery within a heterogeneous multimedia video-on-demand distribution system having service provider equipment and at least one set top terminal, comprising the steps of:
> determining at the service provider equipment, for each set top terminal (STT) requesting a session for video content in the heterogeneous multimedia video-on-demand distribution system, a capability level of said STT and a capability level of the distribution network;
> selecting, from a plurality of available video content and navigational asset versions stored on said service provider equipment, one of said versions of video content and navigational assets appropriate to said capability level of said STT; and
> providing, via at least one of a plurality of transmission channels, said selected video content and navigational assets in response to STT communications indicative of a need for said video content and assets,

283578-1

Serial No. 09/458,321
Page 9 of 13

> said navigational assets comprising a plurality of applets, said applets
> being stored at said service provider equipment, where each applet
> comprises video information, graphics information, and control
> information, and wherein said STT being configured to selectively tune,
> downconvert, and depacketize said video content and assets received via
> said transmission channels." (emphasis added).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). None of the cited references, either singly or in combination, teach or suggest the Applicants' invention as a whole, since the references fail to teach or suggest "said navigational assets comprising a plurality of applets, said applets being stored at said service provider equipment, where each applet comprises video information, graphics information, and control information."

By way of clarification, the Applicants' specification (and claims) provide for navigational assets having a specific structure, rather than a conventional GUI, as follows:

> [s]ession control commands, such as navigation commands, are implemented by
> the session controller 145 with the set top terminal 136. Each command is
> implemented by the execution of an applet by the set top terminal 136. The
> applet is stored in the provider equipment (e.g., in asset storage module 125),
> and is transmitted to the set top terminal 136 (via the FDC or FATC) by the
> session controller 145 in response to requests transmitted by the set top terminal
> 136 (via the RDC). It is noted that each applet includes links to other applets
> stored within the provider equipment 102. In this manner, the server-centric
> topology provides for the conservation of set top terminal memory, processing
> capabilities and bandwidth.
>   It should be noted that each applet comprises control information,
> graphics information and video information. The video information is derived
> from video asset data, the control information is derived from control asset data,
> and the graphics information is derived from graphics (and textual) asset data.
> The video asset data, control asset data and graphics asset data are stored in
> the asset storage module 125. (see Applicants' specification, page 5, lines 20-33,
> emphasis added).

By contrast, the Sahai reference discloses:

283578-1

PAGE 11/15 * RCVD AT 9/15/2004 1:41:18 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/3 * DNIS:8729306 * CSID:732 530 9808 * DURATION (mm-ss):04-40

Serial No. 09/458,321
Page 10 of 13

Media delivery properties or preferences/ specifications as chosen by the user are also shipped across to the server. Typical delivery properties chosen by the user, through a conventional graphical user interface (GUI) provided for this purpose or based on prompts of the user can include parameters such as: Packet length, ... (see Sahai, col.46, lines 9-15 (emphasis added)).

Further, the Sahai reference discloses:

it is possible for the server 10, at the time of an initial hit on the home page for a multimedia service, to send or stream an application to the client, such as a JAVA™ applet application in response to the initial HTTP request. However, because of the security features of JAVA which prevent "invasion" of or "snooping-in" the client 12 by a JAVA applet, the application sent by the server to the client is limited to asking (prompting) the user to supply the capability information of the client and asking for user specifications/preferences using specific questions, such as "What is the processor type of your machine?" The returned information can then be stored on the server 10 across multiple invocations of the server 10 by the client 12, so that the same questions do not get asked of the user for each request of a new asset. (see Sahai, col. 6, line 57 to col. 7, line 9, (emphasis added)).

Nowhere in the Sahai reference is there any teaching or suggestion of "each applet comprises video information, graphics information, and control information." This is to be expected, since the invention is not limited to a JAVA applet, it is noted that the problems discussed with respect to JAVA do not apply. That is, the invention is not directed to the above-described problems addressed by Sahai.

Furthermore, the combined teachings of the Shaw and Utsumi references fail to bridge the substantial gap as between the Sahai reference and the Applicants' invention. In particular, Shaw discloses:

> "[t]he connection between the requesting display engine and the protocol engine forms an adaptive internet protocol link. The first phase in this link is to pass parameters identifying the characteristics of the client device and network connection to the protocol engine. These include the local performance factors and the supported display operations table, and the bandwidth of the connection. The adaptive internet protocol link then tunes itself for optimal performance for the given connection and client device. Finally, the display screens of the application are displayed on the client using display operations supported by the client device. The adaptive internet protocol link and, in particular, the protocol engine, monitors any changes in the network connection between the protocol engine and the display engine." (See Shaw, col. 11, lines 19-45).

283578-1

Moreover, Utsumi discloses a data exchange process that performs a series of processing operations to convert data as an application service into another data in correspondence with the attribute of each terminal or communication infrastructure. (See Utsumi, column 14, lines 48-52 and Figure 2). A terminal data management section 2 manages attributed data representing the processing capability such as a CPU capability, a display capability, and a memory capacity of each terminal connected to the server 1. (See Utsumi, column 15, lines 45-55). Further, "when a plurality of terminals and a plurality of communication networks are present on a network, service data provided by the data processing unit is converted in correspondence with the processing capability of each communication network. (See Utsumi, column 6 lines 6-16).

The combined teachings of these three references discussed above are completely silent with respect to the Applicants' claimed feature of "each applet comprises video information, graphics information, and control information." In the Office Action, it is asserted that the applets inherently comprise video, graphical, and control information to enable display and interactivity in the graphical user interface (see Sahai, col. 4, lines 9-15 above). The Applicants' respectfully disagree.

For a missing element to be inherent, "extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Roberston, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (internal quotations omitted) (emphasis added).

In particular, it is not inherent that an applet includes a video layer. In fact, a graphical user interface (GUI) does not include a video layer. Rather, a graphical user interface includes GUI elements, where each element is defined as a class widget (i.e., icons, pull-down menus, buttons, selection boxes, progress indicators, on-off checkmarks, scroll bars, among other devices for displaying information and for inviting, accepting, and responding to user actions) from which object instances can be created

283578-1

for an application. The GUI elements forming a graphical user interface are all formed by a graphical layer rendered using graphics processing means, rather than video processing means, and associated graphics control information. Accordingly, it is not inherent that a video layer is necessarily present in the applets sent from the server to the set top terminals, as recited in the Applicants' claimed invention. Therefore, the combination of Sahai, Shaw, and Utsumi fail to teach or suggest the Applicants' invention as a whole.

As such, the applicants submit that claim 10 is not obvious and fully satisfies the requirements under 35 U.S.C. §103 as patentable thereunder. Likewise, independent claims 17 and 23, as amended, recite similar limitations as recited in independent claim 10. As such, the applicants submit that claims 17 and 23 are not obvious and fully satisfy the requirements under 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 11-13, 15-16, 18, 20-22, and 24-26, and 28-29 respectively depend, either directly or indirectly, from independent claims 10, 17, and 23 and recite additional features thereof. As such, and for at least the same reasons as discussed above, the applicants submit that these dependent claims are also not obvious and fully satisfy the requirements under 35 U.S.C. §103 and are patentable thereunder. Therefore, the applicants respectfully request that the rejections be withdrawn.

263578-1

Serial No. 09/458,321
Page 13 of 13

CONCLUSION

Thus, the applicants submit that all the pending claims are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Steven M. Hertzberg, Esq. or Eamon J. Wall, Esq. at (732) 530-9404 so appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

_9/15/04_

E/Wall

Eamon J. Wall, Attorney
Reg. No. 39,414
(732) 530-9404

Moser, Patterson & Sheridan, LLP
Attorneys at Law
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702